

REMARKS

Claim 1 was presented for examination and was rejected. Reconsideration of this application, and allowance of claim 1 as previously amended, are hereby respectfully requested.

Examiner Pond and the undersigned had a telephonic interview on May 9, 2006, during which claim 1 was discussed. No agreement was reached regarding claim 1. Examiner Pond and the undersigned did, however, begin to converge on a common vocabulary to use in discussing this invention and the prior art. The fact that it has taken until May 2006 to begin to converge on such a common vocabulary is an indication of the non-obviousness of the present invention as recited in claim 1.

In his first numbered paragraph, the Examiner rejected claim 1 under 35 U.S.C. §103(a) as being unpatentable over Frankel in view of Asay.

Applicants' claim 1 is patentably distinct over the combination of Asay and Frankel, for at least the following reasons:

1. Claim 1 recites that the warranty comprises a contract between the entity (that issued the digital certificate to the subscriber) and the subscriber, the relying party being a third-party beneficiary to the contract. This recitation is not suggested by the cited references, whether they are considered alone or in combination.

2. Claim 1 recites that the relying party sends a validation request, which is separate and apart from the warranty request that is sent by the subscriber. This recitation is not suggested by the cited references, whether they are considered alone or in combination.

3. Claim 1 recites that the validation request is sent to a relying participant that is separate and apart from the entity that issues the digital certificate to the subscriber and that

receives the warranty request from the subscriber. This recitation is not suggested by the cited references, whether they are considered alone or in combination.

On page 2 of his previous Office Action mailed August 25, 2005, the Examiner admitted that Applicants' arguments filed June 9, 2005 were persuasive. The thrust of those arguments was that Asay does not suggest the novel recitations of claim 1. As a result of the distinctions between the present invention and Asay, Applicants are able to offer a simpler, more elegant solution than Asay, without having to rely upon Asay's cumbersome reliance manager 218. In view of the admitted failure of Asay to suggest claim 1, the Examiner cited Frankel in the present Office Action.

In analyzing Frankel, it should be noted that Frankel's "warrantee" is roughly analogous to claim 1's "relying party," and that Frankel's "warranty subject" is analogous to claim 1's "subscriber." Frankel column 4 lines 26-34; column 5 lines 32-40. Also note that Figure 4 of Frankel is reversed across an imaginary vertical axis bisecting said Figure, compared with Figure 1 of Applicants' drawings. Applicants' relying party is depicted in the lower right of their Figure 1 (as relying customer number 108), and Applicants' subscribing party is depicted in the lower left of their Figure 1 (as subscribing customer number 106). The analogous entities in Frankel are the warrantee and requestor (Client 1), which appears on the lower left of Frankel's Figure 4, and the warranty subject (Client 2), which appears in the lower right of Frankel's Figure 4.

There is no suggestion in Frankel of claim 1's recitation of "the warranty comprising a contract between the entity and the subscriber, a relying party being a third-party beneficiary to the contract" (point of distinction No. 1 as enumerated above.)

Furthermore, claim 1 recites that the relying party sends a validation request to a relying participant, said relying participant being in communication with the entity that issues digital

certificates to the subscriber and receives warranty requests from the subscriber. Said relying participant then transmits a validation response to the relying party. Frankel does not suggest the recitation of the relying party (analogous to Frankel's warrantee) sending a validation request separate and apart from the warranty request (point of distinction No. 2 as enumerated above). Nor does Frankel suggest the claim 1 recitation that the validation request is sent to a relying participant that is separate and apart from the entity that issues the digital certificate to the subscriber and that receives the warranty request from the subscriber (point of distinction No. 3 as enumerated above).

In summary, Frankel does not suggest at least three of the recitations in claim 1.

If we combine Frankel with Asay, we still don't produce a combination that suggests the novel recitations of claim 1. For example, Asay does not suggest claim 1's recitation of the relying party sending a validation request that is separate and distinct from the original warranty request (point of distinction No. 2 as enumerated above). Applicants traverse the Examiner's statement (made on page 5 of his Office Action) that in Asay, "relying party sends a validation request." Request 216, cited by the Examiner at this point in his Office Action, is a request for the original warranty (which Asay refers to as a "secondary certificate"), not a request for validation of the warranty. Asay column 32 lines 27-37.

Similarly, Asay does not suggest the points of distinction Nos. 1 and 3 as enumerated above.

For the above reasons, the Examiner is requested to withdraw his rejection of claim 1, and to allow this claim as amended.

Applicants believe that this application is now in condition for allowance of the sole claim herein, claim 1 as previously amended, and therefore an early Notice of Allowance is respectfully requested. If the Examiner disagrees or believes that, for any other reason, direct contact with Applicants' attorney would help advance the prosecution of this case to finality, he is invited to telephone the undersigned at the number given below.

Respectfully submitted,

date of signature: *June 22, 2000*



Edward J. Radlo
Attorney Under Rule 34
Reg. No. 26,793

SONNENSCHN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
Tel.: (415) 882-2402

cc: IP/T docket CH
L. Miller (via e-mail)(Warranty)
K. Ruthenberg